

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Offic**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/866, 279 05/30/97 DYMECKI

S 234805

HM22/0714

EXAMINER

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BAKER, A

ART UNIT	PAPER NUMBER
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1602

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DATE MAILED:

07/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action	Application No. 08/866,279	Applicant(s) Dymecki
	Examiner Anne-Marie Baker, Ph.D.	Group Art Unit 1632

THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) expires _____ months from the mailing date of the final rejection.
- b) expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- Appellant's Brief is due two months from the date of the Notice of Appeal filed on Mar 14, 2000 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Jun 6, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- The proposed amendment(s):

- will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- will not be entered because:
 - they raise new issues that would require further consideration and/or search. (See note below).
 - they raise the issue of new matter. (See note below).
 - they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

- Applicant's response has overcome the following rejection(s):

- Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

The assertion that functional recombination is not required because the invention has the utility of tracing cell lineages even in the absence of gene activity relies on a non-specific utility of the invention. (continued under "Other" below)

- The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

Claims rejected: 1-49

- The proposed drawing correction filed on _____ has has not been approved by the Examiner.

- Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____.

- Other (cont.) *Cell lineage tracing is not a specific utility because any piece of DNA inserted into the genome can be used to trace cell lineage. Applicants argue that functional recombination is not essential for operability of the invention. However, there is not a specific and substantial utility for the invention when recombination produces a non-functional gene. Thus, functional recombination is essential to the operability of the invention.*

Scott D. Priebe
SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER